



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,500	08/19/2003	James G. Chaussee	J-3789	5529
28165	7590	10/17/2007		
S.C. JOHNSON & SON, INC. 1525 HOWE STREET RACINE, WI 53403-2236			EXAMINER CHANNAVAJJALA, LAKSHMI SARADA	
			ART UNIT 1615	PAPER NUMBER
			MAIL DATE 10/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/643,500

Applicant(s)

CHAUSSEE ET AL.

Examiner

Lakshmi S. Channavajjala

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-26 are pending in the instant application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7-27-07 has been entered.

The following is a new rejection in view of the amendment of claims:

1. Claims 25-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Instant claims recite that the limitation "the composition has greater number of bubbles relative to a second composition prepared according to the Monsoon US patent No. 5,902,225", which is indefinite because the cited patent recites more than one example in which each composition has a different viscosities and also describes various alternative methods of preparing the composition (col. 9). Thus it is unclear as to which method of the patent applicants are referring to. A clarification and appropriate is requested.

The following rejection of record dated 9-27-06 has been maintained:

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,902,225 to Monson in view of EP 170 269 (EP) (both submitted on PTO-1449).

Monson teaches (applicants admit on page 1 of the instant specification) a post foamable skin or hair compositions composition comprising a concentrate and a diluent, of which the former reads on the instant "intermediate" (see examples). Examples 1-9 reveal that the concentrate of Monson comprises surfactants such as decyl polyglucoside, triethanolamine, isobutene, isopentane (read on instant propellants), Carbopol (polymer), an emollient such as dimethicone copolyol (reads on the moisturizer of claim 1 and 17) and other additives. The diluent of the composition contains sodium bicarbonate and citric acid (examples). The ratio of citric acid to bicarbonate taught by Monson is within the range of instant claim 13.

Instant claim 1 recites 8% to 12% of diluent and claim 17 recites 4.6% to 7.4% of blend by the weight of the shaving cream. Instant claims 25 and 26 recite greater number of bubbles relative to a second composition prepared according to the Monsoon US patent No. 5,902,225. Instant claims 25 and 26 recite greater number of bubbles relative to a second composition prepared according to the Monsoon US patent No.

Art Unit: 1615

5,902,225. It has been explained in the previous section that instant claims are vague because instant claims are not clear as to which method of Monsoon is being referred to. However, instant claims only recite greater number of bubbles but fail to state as to greater in what magnitude- one more bubble or how many more bubbles.

Monson fails to teach the claimed ratios or the percentages of the blend capable of generating carbon dioxide, the blend of polymer, ratios of the propellants isopentane and isobutene or the claimed moisturizers. However, generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Accordingly, optimizing the percentages or ratios of the blend capable of generating carbon dioxide, and the ratios of the propellants isopentane and isobutene, to achieve a post-foaming composition with the appropriate amount of foam (number of bubbles) would have been readily evident to a skilled artisan at the time of the instant invention was made because Monsoon teaches all of the ingredients for a post foaming composition.

Monson suggest several polymers for adjusting the viscosity of the composition (col. 7, L 35-44) and accordingly, in the absence of any unexpected advantage, one of an ordinary skill in the art would have employed one or more polymers for adjusting the

Art Unit: 1615

viscosity of the composition at the desired level. Monsoon further teaches the composition as a post-foaming preparation that is present in a container, wherein the pressure of the composition when present in the composition is between 10-60 psig and includes the claim limitations of 15 and 16.

Monson fails to teach the claimed lactic acid and specific moisturizers. EP also teaches skin or hair compositions in the form of shampoos, conditioners etc., similar to Monson. The composition of EP also comprises a substance capable of emitting carbon dioxide (foamable- see page 12, last line of EP), in addition to surfactants, vitamin E acetate (reads on claimed moisturizers of claims 2 & 19), lactic acid, lactate, etc (see examples 9, 11, 12 etc), the entire composition being present in a container. EP teaches addition of organic acids such as citric acids, lactic acids as pH modifiers to the final composition (pages 8 & 9). Thus both Monson and EP are directed to foamable compositions and accordingly it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. It would have been obvious for one of an ordinary skill in the art at the time of the instant invention was made to include lactic acid and vitamin E acetate of EP in the post-foaming composition of Monson because EP suggests that the acids such as lactic acid provide buffering activity and both the references desire the presence of components such as emollients, skin treatment or conditioning agents such as glycerin, humectants, antibacterial agents, vitamins etc.

Response to Arguments

Applicant's arguments filed 6-27-07 have been fully considered but they are not persuasive.

Applicants argue that Monson is deficient in disclosing the size or number of bubbles, which is a surprising result on page 6 of the composition. However, instant claim 1 does not recite any pressure and further it is unclear as to what composition (including the amounts of diluents and intermediate) are compared with which specific composition of the instant invention and if the instant composition employed in the results have the amounts of diluents in the same range as claimed. Applicants admit that Monson recognize gas producing component as a diluent. While applicants state that the composition of Monson employed contains 2.45% diluent according to the description of the reference, it is stated instant composition requires no more than 12% of diluent. However, examiner notes that instant claims 1 and 17 while reciting the amount of diluent do not recite the gas bubbles, their number or size. On the other hand, claims 25-26 recite "greater number of bubbles" but fail to recite greater to what extent. Further, the argued limitation of the surface area of the bubbles is not present in the claims pending. Therefore, the argument regarding unexpected advantage is not commensurate with the scope of the claims.

Applicants argue that Monson's deficiencies cannot be overcome when considered in combination with EP 170269 ("EP") because EP teaches dermatological products for the treatment and is not analogous art to applicants' invention. It is argued that in contrast, applicants' invention includes no medicament of any sort. The argument is not persuasive because instant "comprising" language allows for the presence of medicaments or skin treatment agents of EP and besides skin preparation compositions do not in any way reflect that medicaments should not be included. Further, instant claimed vitamins, aloe vera etc (claim 2) provide dermatological and therapeutic effect in terms of antioxidant and moisturizing effects respectively.

EP clearly states that the compositions prepared in pressure resistant containers containing carbon dioxide (pages 10-11) and that a pH modifier (applicants admit that EP teaches lactic acid as a pH modifier) to generate

Art Unit: 1615

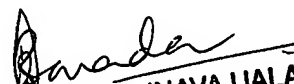
carbon dioxide. Thus, with respect to lactic acid the teachings of EP are no different from that of instant. Hence EP provides the requisite motivation and suggestion to add lactic acid to the composition of Monson.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 7.00 AM -4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AU 1615
October 15, 2007


LAKSHMI S. CHANNAVAJJALA
PRIMARY EXAMINER